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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,937	09/28/2005	Atsumi Mori	IWI-16232	4648
7609 7590 09/25/2008 RANKIN, HILL & CLARK LLP 925 EUCLID AVENUE, SUITE 700 CLEVELAND, OH 44115-1405			EXAMINER KARPINSKI, LUKE E	
			ART UNIT 1616	PAPER NUMBER
			MAIL DATE 09/25/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/550,937	<b>Applicant(s)</b> MORI ET AL.	
	<b>Examiner</b> LUKE E. KARPINSKI	<b>Art Unit</b> 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3,5-8 and 10-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,5-8, and 10-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/31/2008 has been entered.

### ***Claims***

Claims 2, 4, and 9 have been canceled by applicant.

Claims 1, 3, 5-8, and 10-12 are currently pending and under consideration in this action.

### ***Notes on amendment to claim 1***

Claim 1 has been amended to contain a specific gravity range. It is noted that such a range is **NOT** disclosed within the instant specification. However, the specification does disclose the upper and lower limit, as well as several points in-between. This amendment is **NOT** viewed as new matter. The amendment overcomes *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976), because the instant amendment has an upper and lower limit and the claim was not broadened in scope.

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***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Applicant Claims
2. Determining the scope and contents of the prior art.
3. Ascertaining the differences between the prior art and the claims at issue, and resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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**1. Claims 1, 3, and 5-8 are rejected under 35 U.S.C. 103(a)** as being unpatentable over US Patent No. 5,612,021 to Mellul.

***Applicant Claims***

Applicant claims a composition comprising, 1-30% wax, 0.1-25% resin, 0.01-20% hollow resin powder, wherein the hollow resin powder has a specific gravity of 0.02 to 0.65.

Further claimed by applicant is a ratio of said components, a colorant, a thickener, and a specific gravity and hardness of said compositions.

***Determination of the Scope and Content of the Prior Art (MPEP §2141.01)***

Mellul teaches mascaras (col. 1, lines 12-13), 0.1-50% and 15% wax (col. 5, line 52 to col. 6, line 33 and example 3), 0.5-15% resin (col. 7, lines 1-6), 0.5-30% hollow organic powder (col. 3, line 36 to col. 4, line 21), as claimed in claim 1. It is noted by the examiner that Expancel is a line of hollow inorganic powders having specific gravities within said claimed range, as evidenced by the Expancel product specification sheet provided with this action.

Mellul further teaches said composition comprising 0.5-30% colorant, (col. 3, lines 36-37), as pertaining to claim 5, and 0.5% gum arabic (example 1), which reads on claim 6.

***Ascertainment of the Difference between Scope the Prior Art and the Claims (MPEP §2141.012)***

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Mellul does not explicitly teach an example wherein the claimed ingredients and percentages are combined in a single formulation. However, Mellul does teach all of the claimed components within the claimed percentage ranges.

***Finding of Prima Facie Obviousness Rational and Motivation***

***(MPEP §2142-2143)***

Regarding claims 1, 5, and 6, it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to select said ingredients and combine them as instantly claimed because Mellul suggests that the instant ingredients can be combined mixed together. In a prior art reference it is not necessary for all the possible compositions to be exemplified in the examples in order for the art to render an invention obvious.

One of ordinary skill in the art would have been motivated to combine said ingredients because Mellul teaches that it may be done. Therefore it would have been obvious to combine the instant ingredients into a single formulation as taught by Mellul.

Regarding claim 3 and the instantly claimed ratio. It would have been obvious for one of ordinary skill in the art at the time of the invention to produce the formulations of Mellul with the ratio of instant claim 3.

One of ordinary skill would have been motivated to do this because Mellul teaches percentage ranges for each of the 3 components in said ratio. It is considered routine optimization for one to simply alter the percentages of components in a formulation and it would have been expected that one of ordinary skill would have done so in order to achieve the desired properties. It is the examiner's position that the

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claimed ratio is so broad that utilization of a majority of the percentages of the wax, resin, and hollow resin powder, would necessarily fall within the claimed ratio range.

Regarding claims 7 and 8, Mellul teaches the same components present within the claimed ranges. Compositions and their properties cannot be separated.

Therefore, the compositions of Mellul necessarily have the properties claimed in instant claims 7 and 8.

From the teachings of the reference, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

**2. Claims 10-12 are rejected under 35 U.S.C. 103(a)** as being unpatentable over US Patent No. 5,612,021 to Mellul in view of the 3M Scotchrite Glass Bubbles literature, referred to as Scotchlite in the remainder of this action.

### ***Applicant Claims***

Applicant claims the composition of claim 1, further comprising a hollow inorganic powder

### ***Determination of the Scope and Content of the Prior Art (MPEP §2141.01)***

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The teachings of Mellul are delineated above. In particular, Mellul teaches inorganic powders (e.g. titanium dioxide), as well as, hollow microspheres (col. 3, line 39 to col. 4, line 21).

***Ascertainment of the Difference between Scope the Prior Art and the Claims  
(MPEP §2141.012)***

Mellul does not teach a hollow glass powder or a hollow inorganic powder as claimed in claims 10 and 11. This deficiency in Mellul is cured by Scotchlite. Scotchlite teaches hollow inorganic glass bubbles for utilization in cosmetics (page 1).

***Finding of Prima Facie Obviousness Rational and Motivation  
(MPEP §2142-2143)***

Regarding claims 10-12, it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to produce the formulations of Mellul with the glass bubbles of Scotchlite in order to produce the invention of instant claim 10-12.

One of ordinary skill in the art would have been motivated to do this because Mellul teaches the utilization of both inorganic powders and hollow microspheres. Therefore it would have been obvious to utilize the hollow glass inorganic microspheres of Scotchlite, with the formulations of Mellul in order to impart the properties of said hollow glass inorganic microspheres onto said formulations.

From the teachings of the reference, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed

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invention. Therefore, the invention as a whole would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

### ***Conclusion***

Claims 2, 4, and 9 have been canceled by the applicant.

Claims 1, 3, 5-8, 10-12 are rejected.

No claims are allowed.

### ***Inquiries***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LUKE E. KARPINSKI whose telephone number is (571)270-3501. The examiner can normally be reached on Monday Thursday 9-4 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LEK

/Mina Haghighatian/  
Primary Examiner, Art Unit 1616